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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,317	12/29/2003	Alex Brown	1801270.00137US1	8023
23483 7590 02/05/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER KHATRI, ANIL	
			ART UNIT 2191	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			NOTIFICATION DATE	DELIVERY MODE
3 MONTHS			02/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/05/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/748,317

Applicant(s)

BROWN ET AL.

Examiner

Anil Khatri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 5-18, 29-41, 45-59, 70-82, 86-100 and 111-123 is/are rejected.
- 7) ☒ Claim(s) 19-28, 60-69 and 101-110 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/29/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070131.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "*Method and Apparatus for Performing Native Binding And To Execute Native Code*".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-123 are rejected under 35 USC 101 because they disclose a claimed invention that is an abstract idea as defined in the case *In re Warmerdam*, 33, F 3d 1354, 31 USPQ 2d 1754 (Fed. Cir. 1994).

Analysis: Claims 1-123 disclosed by the applicant as being a "method of performing native binding...". Since the claims are each a series of steps to be performed on a computer the processes must be analyzed to determine whether they are statutory under 35 USC 101.

Examiner interprets that the claims 1-123 are non-statutory because they do not disclose that how a method will carry out its functionality and perform native binding to execute native code with incorporating further steps of translating and processing. Applicant submits no substance to the claims, therefore, claims 1-123 are unable to produce useful results and practical

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application can't be derived. Thus, claims 1-123 are non-statutory and rejected under 35 USC 101.

Further, Claim 42-82 are not limited to tangible embodiments instead being defined as including both tangible embodiments (e.g., [computer readable medium]) and intangible embodiments (e.g., [transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line, a signal, etc.]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-123 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: instructions, properly compilation, assembling, loading and linking.

Claims 83-123 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Further, claims 83-123 reciting "in combination" are not clear, incomplete and very vague what applicant is claiming regarding "in combination".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 5-18, 29-41, 45-59, 70-82, 86-100 and 111-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Adams* USPN 6,578,193 taken with *Baumgart et al* USPN 6,578,194.

Regarding claims 1, 42 and 83

Adams teaches,

identifying certain subject program code having corresponding native code (figures 3, 11-12, column 8, lines 44-51, "the builder 86...);

identifying the native code which corresponds to the identified subject program code (column 8, lines 52-65, "by native code is indicated...). *Adams* does not teach explicitly executing the corresponding native code instead of executing a translated version of the identified subject program code. However, *Baumgart et al* teaches (figure 5, column 2, lines 30-44, "translates the source program...). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate certain subject program corresponding to native code. The modification would have been obvious because one of ordinary skill in the art would have been motivated to combine native code and executing corresponding native code and translate with different version to achieve better performance.

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Regarding claims 2, 43 and 84

Baumgart et al teaches,

executing the native function instead of the subject function in the translation of the subject program code (figure 5, column 2, lines 30-44, “translates the source program...).

Regarding claims 3, 44, and 85

Adams teaches,

invoking the native function with the transformed function parameter according to a prototype of the native function (column 9, lines 9-18, “code segments...). *Adams* does not teach explicitly transforming zero or more function parameters from a target code representation to a native code representation and transforming zero or more return values of the invoked native function from a native code representation to a target code representation. However, *Baumgart et al* teaches (figure 5, column 9, lines 2-20, “the binder program...).

Regarding claims 4-18 and 29-41

Rejection of claims 1-3 is incorporated and further claims 4-18 and 29-41 recites similar limitations from claim 1-3 therefore, claims 4-18 and 29-41 are rejected under same rational.

Regarding claims 45-59 and 70-82

Rejection of claims 42-44 is incorporated and further claims 45-59 and 70-82 recites similar limitations from claim 42-44 therefore, claims 45-59 and 70-82 are rejected under same rational.

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Regarding claims 86-100 and 111-123

Rejection of claims 83-85 is incorporated and further claims 86-100 and 111-123 recites similar limitations from claim 83-85 therefore, claims 86-100 and 111-123 are rejected under same rational.

Allowable Subject Matter

Claims 19-28, 60-69 and 101-110 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil Khatri whose telephone number is 571-272-3725. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ANIL KHATRI
PRIMARY EXAMINER